

REMARKS

The Office Action dated December 1, 2001, has been received, its contents carefully noted, and the applied citations thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

Rejections under 35 U.S.C. §112

The Examiner has rejected claims 4 and 5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention.

Original claim 4 stated "rewarding success by transport to a player's designated site." Claim 4 has been amended to state "rewarding success by electronic transport to a player's designated network site."

Original claim 5 stated "rewarding success by personal redemption at a casino." Claim 5 has been amended to state "rewarding success by allowing redemption of an award in person at a casino."

Undersigned wishes to make explicit that this revision is not be construed as a *Festo*-type narrowing. Rather, the revisions are intended to assure conformance with 35 U.S.C. § 112 in general and paragraph 2 in particular.

Rejections under 35 U.S.C. §102

The Examiner has rejected claims 1 through 4, 6, 7, and 9 through 15 under 35 U.S.C. §102(e) as being anticipated by Eggleston et al (USP 6,061,660).

With respect to rejections under 35 U.S.C. § 102, the Examiner is invited to consider the following binding, compelling precedent articulated by the Court of Appeals for the Federal Circuit:

“. . . anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.” *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986).

Further, “those elements must either be inherent or disclosed expressly . . .” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 2 U.S.P.Q.2d 1051 (Fed. Cir. 1987). “. . . and must be arranged as in the claim[s] . . .” *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986).

In addition, “. . . [the] absence from the reference of any claimed element negates anticipation.” *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986).

Eggleston et al. discloses a system and method for designing and implementing incentive programs, which includes allowing consumers to participate in incentive programs offered by various sponsors and receive awards for particular outcomes. Sponsors or retailers may select particular prizes for games and players may play for these awards.

The present invention differs from Eggleston et al. in that it has no connection to any physical site. The games and information offered by the present invention are related to games offered at a particular gaming establishment or family of gaming establishments. A player in Eggleston et al. may indeed choose to redeem a prize from a retailer in person, but this is not analogous to the ability to query a network system regarding play on particular physical machines offering specific awards at a particular

gaming establishment. Eggleston et al. is limited solely to an Internet presence with regard to gaming. Thus, the element of the present invention allowing information exchange regarding a physical entity is missing from Eggleston et al. Without this element, a rejection under 35 U.S.C. §102 cannot stand.

Claims 1, 7, and 10 have been amended to make explicit that which was previously implicit, namely, the connection of the (physical) site of a gaming establishment. This amendment is not to be construed as a *Festo*-type limitation.

Moreover, the present invention differs from Eggleston et al. in that a player of games offered in the present invention is not merely playing a game for a potential award; the games of the present invention inherently include wagering on the game played. Thus, the present invention includes an input component (wagering) that is missing from Eggleston et al. Eggleston et al. makes no provision for actual wager input (and associated accounting processes) involving a player. Accordingly, Eggleston et al. does not anticipate any of the claims of the present invention, and the rejection of claims 1 through 4, 6, 7, and 9-15 should be withdrawn.

Rejections under 35 U.S.C. §103

The Examiner has rejected claims 5 and 8 under 35 U.S.C. §103(a) as being unpatentable over Eggleston et al. (6,061,660) in view of Goldberg et al. (5,823,879).

Undersigned has read these patents carefully and has failed to uncover the basis by which the Examiner has combined these references to support an obviousness type rejection. Stated alternatively, there is no teaching within these citations which would warrant the combination of elements proposed by the Examiner and it is respectfully stipulated that applicant's structure would still not be obtained thereby. A specific teaching within one of the references suggesting the combination is required:

Undersigned provides the Examiner guidance with respect to rejections under 35 U.S.C. § 103 which is binding, compelling precedent from the Court of Appeals for the Federal Circuit.

"When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself." *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

"Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination." *Lindemann Mashinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

"It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 437 F.2d 1044 (Fed. Cir. 1988).

These precedents from the Court of Appeals for the Federal Circuit are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a *prima facie* case of obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied

upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", see *In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

The Examiner has failed to meet these threshold requirements to establish prima facie obviousness. In the absence of such a prima facie showing, the Examiner's rejection cannot stand:

"Decision rejecting claims in utility application as obvious over combination of prior art references must be reversed, since obviousness analysis in decision is limited to discussion of ways that multiple references can be combined to read on claimed invention, but does not particularly identify any suggestion, teaching, or motivation to combine references, and does not include specific or inferential findings concerning identification of relevant art, level of ordinary skill in art, nature of problem to be solved, or any other factual findings that might support proper obviousness analysis." *In re Dembicza*k, 50 U.S.P.Q.2d 1614. [Emphasis added.]

Eggleston et al. is discussed hereinabove. It lacks both the element of information exchange regarding a physical establishment and the capacity for actual wager input. The Examiner further states at page 3 of the Office Action that Eggleston et al. also lacks "personally redeeming awards at a casino (Claim 5) and providing updates to a machine at a casino (Claim 8). Notably, Eggleston discloses both these features, but not in association with a casino." Further, the Examiner goes on to state that "Internet websites sponsored by casinos are notoriously well known" at page 4 of the Office Action.

As mentioned above, the option to redeem prizes through a retailer who may or may not be directly associated with a gaming website is not analogous to the present invention. The proper discussion at issue is not mere "sponsorship" of a website or playing "casino-style" games online, nor is it mere "on-line gaming". The present invention offers both information and wagering propositions in connection with a particular gaming establishment.

Goldberg et al. does not cure the deficiencies of Eggleston et al. At col. 1, lines 39-44, Goldberg et al. opines that "it would be desirable to . . . play casino-style games on the Internet for prizes at a reduced risk or substantially no risk . . ." The patent discloses a network gaming system in which players may game continuously and asynchronously and in which games may be played on the Internet. Information is collected about players and used to broadcast advertisements of interest to that particular player.

The instant invention provides a means to gather information about a particular gaming establishment or family of gaming establishments to aid in trip planning. A potential player may choose an award of interest and receive information regarding the path to follow in pursuing that particular award (which machines to play *at the gaming establishment* or where particular types of gaming machines or propositions are offered *at the actual gaming establishment*). Additionally, a player, on his local machine, may initiate an actual wagering game *at the gaming establishment* associated with the network/website. These gaming propositions are not the same as Goldberg et al.'s "reduced risk or substantially no risk" games. Goldberg et al. has nothing to do with information acquisition regarding a particular gaming establishment or family of establishments; it merely allows players to play games and receive concurrently-

displayed advertisement information customized to their particular interests. The combination of Eggleston et al. with Goldberg et al., therefore, does not provide the instant invention. The Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. §103.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Respectfully Submitted:



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